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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,606

02/18/2004

Maureen M. Farinella

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01/27/2006

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EXAMINER

KAYES, SEAN PHILLIP

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/782,606

Applicant(s)

FARINELLA ET AL.

Examiner

Sean Kayes

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/12/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 9-14, 16-18, 20-26, and 28-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yao (US 6424984.)

3. With respect to claim 1 Yao discloses a bookmark having an integrated electronic timer circuit, comprising: a substrate (4, figure 2); a header (2 figure 2) integral with the substrate, the header including a display (6 figure 1) and control panel (figure 4); and an electronic timer circuit (column 2 lines 43-49) housed within the header for receiving commands from the control panel and providing a timer signal to the display.

4. With respect to claim 2 Yao discloses the bookmark of claim 1, wherein the control panel includes a plurality of control buttons (figure 4) for controlling the electronic timer circuit.

5. With respect to claim 3 Yao discloses the bookmark of claim 2, wherein at least one of the plurality of control buttons (8, figure 1) is disposed on a side portion of the header.

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6. With respect to claim 4 Yao discloses the bookmark of claim 1, further including a sensor (8, figure 1) for sensing an external condition and controlling the electronic timer circuit in response thereto (sensor is a pressure sensitive button.)

7. With respect to claim 5 Yao discloses the bookmark of claim 1, further including a light source (6 figure 1) disposed on the header.

8. With respect to claim 9 Yao discloses the bookmark of claim 1, wherein the electronic timer circuit includes a memory (column 2 lines 43-49) for storing a timer count value.

9. With respect to claim 10 Yao discloses a bookmark, comprising: a substrate portion (4 figure 1); and a header portion (2 figure 1) integral with the substrate portion, the header portion including an electronic timer (48 and 50 figure 5.)

10. With respect to claim 11 Yao discloses the bookmark of claim 10, wherein the header portion includes: a display (6, figure 1) coupled for receiving a signal from the electronic timer; and a plurality of control buttons (figure 4) for controlling the electronic timer.

11. With respect to claim 12 Yao discloses the bookmark of claim 11, wherein at least one of the plurality of control buttons (8 figure 1) is disposed on a side of the header portion.

12. With respect to claim 13 Yao discloses the bookmark of claim 10, further including a sensor (8 figure 1) for sensing an external condition and controlling the electronic timer in response thereto.

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13. With respect to claim 14 Yao discloses the bookmark of claim 10, further including a light source (6 figure 1.)

14. With respect to claim 16 Yao discloses the bookmark of claim 10, wherein the electronic timer includes a memory (column 2 lines 43-49) for storing a timer count value.

15. With respect to claim 17 Yao discloses a marking device, comprising: means for marking a location (4, figure 1) within reading material; and an electronic timer (column 2 lines 43-49) housed within the means for marking.

16. With respect to claim 18 Yao discloses the marking device of claim 17, wherein the means for marking includes: a substrate (4, figure 1); and a header (2, figure 1) integral with the substrate.

17. With respect to claim 20 Yao discloses the marking device of claim 18, further including: a display (6, figure 1) coupled for receiving a signal from the electronic timer; and a plurality of control buttons (figure 4) for controlling the electronic timer.

18. With respect to claim 21 Yao discloses the marking device of claim 20, wherein at least one of the plurality of control buttons (8, figure 1) is disposed on a side of the header.

19. With respect to claim 22 Yao discloses the marking device of claim 17, further including a light source (6 figure 1) disposed on the means for marking.

20. With respect to claim 23 Yao discloses the bookmark of claim 17, wherein the electronic timer includes a memory (column 2 lines 43-49) for storing a timer count value.

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21. With respect to claim 24 Yao discloses a method of making a bookmark with an integrated electronic timer, comprising: forming a substrate (4, figure 1); forming a header (2, figure 1) integral with the substrate, wherein the header includes a cavity; disposing an electronic timer within the cavity of the header (column 2 lines 43-49); and electrically coupling the electronic timer to a display (6 figure 1) on the header.

22. With respect to claim 25 Yao discloses the method of claim 24, further including the step of providing a plurality of control buttons (figure 4) on the header for controlling the electronic timer.

23. With respect to claim 26 Yao discloses the method of claim 24, further including the step of providing a light source (6 figure 1) disposed on the bookmark.

24. With respect to claim 28 Yao discloses the method of claim 24, wherein the electronic timer includes a memory (column 2 lines 43-49) for storing a timer count value.

25. With respect to claim 29 Yao discloses a method of monitoring time with a bookmark having an integrated electronic timer, comprising: setting a timer count value (48 figure 5) for the electronic timer, which is integrated within a housing of the bookmark; counting the timer count value; and displaying (6 figure 1) the timer count value on the bookmark.

26. With respect to claim 30 Yao discloses the method of claim 29, wherein the step of setting a timer count value includes activating at least one of a plurality of control buttons (24 and 26 figure 4) for controlling the electronic timer.

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27. With respect to claim 31 Yao discloses the method of claim 29, further including the step of activating a light source (6 figure 1) within the bookmark.

28. With respect to claim 32 Yao discloses the method of claim 29, wherein the electronic timer includes a memory (column 2 lines 43-49) for storing the timer count value.

29. With respect to claim 33 Yao discloses a marking device, comprising: a bookmark having an interior housing (2 figure 1); an electronic timer (column 2 lines 43-49) disposed within the interior housing of the bookmark for counting a count value; a control panel (figure 4 and column 3 lines 11-18) disposed on the bookmark for controlling the electronic timer; and a display (6 figure 1) disposed on the bookmark and electrically coupled to the electronic timer for displaying the count value.

30. With respect to claim 34 Yao discloses the marking device of claim 33, wherein the control panel includes a plurality of control buttons (see figure 4) for controlling the electronic timer.

31. With respect to claim 35 Yao discloses the marking device of claim 33, further including a light source (6 figure 1) disposed on the bookmark.

32. With respect to claim 36 Yao discloses the marking device of claim 33, wherein the electronic timer includes a memory (column 2 lines 43-49) for storing the count value.

***Claim Rejections - 35 USC § 103***

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 6, 15, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yao (US 6424984) in further view of Bailie (US 2319436.)

With respect to claims 6, 15, 19, and 27 Yao discloses the bookmark of claim 1, 10, 18, and 24. Yao does not disclose a magnifying viewing port disposed within the substrate or the associated step of providing said magnifying portion.

At the time of the invention it would have been obvious to one skilled in the art to provide a magnifying portion on the substrate portion of Yao's invention, as taught by Bailie.

The suggestion or motivation for doing so would be add functionality to the bookmark, namely to allow a reader/user with poor eyesight to read small text.

35. Claims 6, 7, 15, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yao (US6424984) in further view of Tanaka (US 5382053.)



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36. With respect to claims 6, 15, 19, and 27 Yao discloses the bookmark of claim 1, 10, 18, and 24. Yao does not disclose a magnifying viewing port disposed within the substrate or the associated step of providing said magnifying portion.

Tanaka teaches attaching a magnifying lens to the substrate of the bookmark.

At the time of the invention it would have been obvious to one skilled in the art to provide a magnifying portion on the substrate portion of Yao's bookmark.

The suggestion or motivation for doing so would be add functionality to the bookmark, namely to allow a reader/user with poor eyesight to read small text.

With respect to claim 7 Yao discloses the bookmark of claim 1, Yao does not disclose a clip coupled to the bookmark.

Tanaka teaches using a clip with a bookmark.

At the time of the invention it would have been obvious to one skilled in the art to attach a clip to Yao's bookmark, as taught by Tanaka.

The suggestion or motivation for doing so would be to allow the device to be clipped to a cover without having to mark a page.

37. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yao (US 6424984) further in view of Ho (US 6024043.)

38. With respect to claim 8 Yao discloses the bookmark of claim 1, Yao does not disclose a string extending from the bookmark for marking a book.

The use of strings to mark multiple pages is well known in the art, as taught by Ho.

Ho and Yao are analogous art because they both deal with the problem of marking pages.

At the time of the invention it would have been obvious to one skilled in the art to attach a string to Yao's invention.

The suggestion or motivation for doing so would be to allow the bookmark to mark more than one page at a time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Kayes whose telephone number is (571) 272-8931. The examiner can normally be reached on 8:00-5:00.

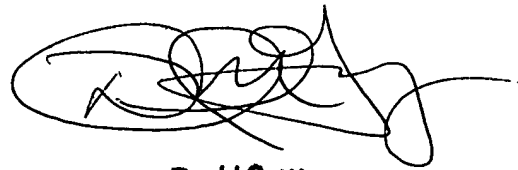
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Gray can be reached on (571)272-2119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'David Gray', with a large, loopy initial 'D' and a trailing flourish.

**David Gray**  
**Primary Examiner**